

**REMARKS**

In the Final Office Action, the Examiner rejected claims 1-9, 11-19, 21-37, 39-43, and 45-48. As noted above, the Examiner also rescinded the previous indication of allowable subject matter based on the new grounds of rejection, including Shkedy (U.S. Pat. No. 6,260,024 B1). As discussed in detail below, the Applicant respectfully asserts that the cited references fail to teach various features recited in the pending claims. For these reasons, the Applicant respectfully requests allowance of all pending claims.

**Claim Rejections under 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-9, 11-19, 21-37, 39-43, and 45-60 under 35 U.S.C. § 103(a) as unpatentable over Pitroda (U.S. Pat. No. 5,590,038) and Barlow et al. (U.S. Pat. No. 6,038,551) and Shkedy in view of each other.

***Legal Precedent***

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art”

based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01.

Fourth, if the Examiner relies on a theory of inherency for certain claim features, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte*

*Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See M.P.E.P. § 2173.05(g); In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

***Independent Claim 1***

As discussed in detail below, the cited references fail to teach or suggest, alone or in combination, a number of features recited by independent claim 1.

First, the cited references fail to teach or suggest “providing access to a *financial analysis* system for a *medical resource supplier* via a network,” as recited by claim 1. In the Office Action, the Examiner asserted that Pitroda discloses this claim feature at col. 16, ll. 13-20; Fig. 31; and col. 17, lines 13-25. *See Paper No. 8, p. 4.* The Applicant respectfully asserts that the Pitroda reference does not disclose the financial analysis system, as suggested by the Examiner. Instead, Pitroda discloses a simple “menu which includes choices such as credit card transactions, bank card transactions, retail credit transactions, medical or insurance transactions, personal identification, travel or telephone, or other miscellaneous transactions.” Pitroda, Fig. 12; col. 16, ll. 15-20. The Applicant asserts that the simple *menu* of Fig. 12 is completely devoid of any sort of *financial analysis* system, as recited by claim 1. The mere ability to select a variety of options on a menu does not imply any sort of financial analysis of those transactions. Regarding Fig. 31 and the corresponding text of Pitroda, the Applicant further emphasizes that Pitroda fails to disclose any sort of

financial analysis system, as recited by claim 1. The remaining references also fail to obviate the deficiencies of the Pitroda reference.

Second, the cited references neither teach nor suggest, taken alone or in combination, the act of “receiving *client trade-in data* for a purchasing transaction for medical resources,” as recited by claim 1. In the Office Action, the Examiner relied on Shkedy for its alleged teaching of client trade-in data at col. 4, ll. 60 *et seq.* and col. 27, ll. 8 *et seq.* See Paper No. 8, p. 3. After careful review of these passages, the Applicant asserts that Shkedy teaches only an exchange of goods or a bartering transaction of goods, rather than any sort of *client trade-in* as recited by claim 1. See Shkedy, col. 8, ll. 15-20; and col. 27, ll. 8-13. Not only does Shkedy fail to explicitly disclose client trade-in data, but client trade-in data is not inherent to the teachings of Shkedy. Based on the legal precedent introduced above, the client trade-in data is not inherent to Shkedy, because it does not necessarily flow from the teachings of Shkedy. Moreover, it would be mere conjecture to say that client trade-in data was inherent to Shkedy. The remaining references also fail to disclose the client trade-in data recited by claim 1. Accordingly, the cited references, taken alone or in combination, fail to teach or suggest the client trade-in data recited by claim 1.

Third, the cited references fail to disclose the act of “providing a plurality of financial transaction options tailored to the client data,” as recited by claim 1. In the Office Action, the Examiner apparently equated the plurality of financial transaction options with a forward purchase order (FPO), as disclosed by Shkedy. See Paper No. 8, p. 3. The Applicant respectfully disagrees with the Examiner’s interpretation of the instant claim and the teachings of Shkedy. As disclosed by Shkedy, a number of buyers create these forward purchase orders (FPOs) 100, which are then aggregated into a single pooled purchase order (PPO) 265. See Shkedy, Abstract; Fig. 1; col. 4, ll. 48-59. However, Shkedy does not provide a *plurality* of financial transaction *options* tailored to the client data, as recited by claim 1. Instead, Shkedy provides the single pooled purchase order (PPO) 265 for bidding by the various sellers, and then subsequently provides a single lowest price to the various buyers. See Shkedy, Abstract; Fig. 1; col. 3, ll. 55-57; col. 17, ll. 32-33. Moreover, the Applicant asserts

that these forward purchase orders (FPOs) and the pooled purchase order (PPO) are simply *orders*, rather than financial transaction *options* as recited by claim 1. For these reasons, the cited references, taken alone or in combination, fail to teach or suggest a plurality of financial transaction options tailored to the client data, as recited by claim 1.

In view of the foregoing deficiencies, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 1 and its corresponding dependent claims.

***Independent Claim 17***

The cited references also fail to teach or suggest certain features recited by independent claim 17.

For example, the cited references fail to teach or suggest “a plurality of financial transaction options tailored to the client data, wherein the client data comprises *trade-in data* for a client trade-in with the financial transaction,” as recited by claim 17. As discussed in detail above with reference to independent claim 1, the cited references taken alone or in combination fail to teach or suggest this claim feature. In the Office Action, the Examiner relied on the Shkedy reference for its alleged teaching of these features. See Paper No. 8, p. 3. However, the Shkedy reference merely teaches a contract involving an exchange of goods or a barter transaction, rather than any sort of client trade-in as recited by independent claim 17. See Shkedy, col. 8, ll. 15-20; col. 27, ll. 8-13. Accordingly, the Examiner has not presented a *prima facie* case of obviousness for the instant claim 17.

For these reasons, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 17 and its corresponding dependent claims.

***Independent Claim 33***

Turning to independent claim 33, the Applicant asserts that the cited references fail to teach or suggest, alone or in combination, a variety of features recited by claim 33.

For example, as discussed in detail above, the cited references fail to disclose *client trade-in information*, as recited by claim 33. In addition, the cited references fail to disclose *lease and loan options* as recited by claim 33. In the Office Action, the Examiner did not provide reference to lease and loan options in any of the cited references. Therefore, the Applicant believes that the Examiner has not presented a *prima facie* case of obviousness for independent claim 33.

In view of these deficiencies, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 33 and its corresponding dependent claims.

***Independent Claim 40***

The cited references also fail to teach or suggest, alone or in combination, certain features recited by independent claim 40.

For example, the cited references do not disclose the act of “providing access to a financial module for a medical resource supplier via a network,” as recited by claim 40. As discussed above with reference to independent claim 1, the Examiner relied on the Pitroda reference for its alleged teaching of this feature at col. 15, ll. 13-20 and Fig. 31 and its corresponding text. *See* Paper No. 8, p. 4. However, these figures and passages of Pitroda disclose only a *menu* of different transactional categories rather than any sort of financial module as recited by claim 40. *See* Pitroda, Fig. 12; col. 16, ll. 15-20; col. 17, ll. 13-18.

In addition, the cited references do not disclose the act of “receiving *client trade-in information* at the financial module,” as recited by claim 40. As discussed in detail above, the Examiner’s reliance on Shkedy is insufficient with regard to this

claim feature. In sharp contrast to the claimed client trade-in information, the Shkedy reference merely discloses exchange and bartering transactions. *See* Shkedy, col. 8, ll. 15-20; col. 27, ll. 8-13. One of ordinary skill in the art would have no reason to believe that any sort of client trade-in information would be involved with such an exchange or bartering transaction.

In view of these deficiencies, the cited references, taken alone or in combination, fail to teach or suggest various features of independent claim 40. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 40 and its corresponding dependent claims.

***Independent Claim 49***

Turning to independent claim 49, the Applicant asserts that the cited references fail to teach or suggest, alone or in combination, various features recited by claim 49.

For example, the cited references all fail to disclose the act of “providing a *plurality of financial transaction options* comprising a *lease option* tailored to the client data,” as recited by claim 49. In the previous Office Action, the Examiner *admitted* that the Pitroda and Barlow references failed to disclose a *lease option*. *See* Paper No. 6, p. 5. However, in the present Final Office Action, the Examiner failed to point to any particular passage or figure of Shkedy to obviate this deficiency of the Pitroda and Barlow references.

Moreover, as discussed in detail above with reference to independent claim 1, the Applicant asserts that the Shkedy reference fails to disclose a *plurality of financial transaction options*, as recited by claim 49. Instead, the Shkedy reference merely discloses a single pooled purchase order 265. *See* Shkedy, Abstract; Summary.

In view of these deficiencies, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 49.

***Independent Claim 50***

For similar reasons as provided above with reference to independent claims 1 and 49, the Applicant asserts that the cited references fail to teach or suggest, alone or in combination, certain features recited by independent claim 50.

Specifically, the cited references do not disclose the act of "providing a *plurality of financial transaction options* comprising a *loan option* tailored to the client data," as recited by claim 50. Again, in the previous Office Action, the Examiner *admitted* that the Pitroda and Barlow references do not disclose a *loan option*. *See* Paper No. 6, p. 5. However, in the present Final Office Action, the Examiner did not specifically address this claim feature of a loan option. Therefore, the Applicant emphasizes that the Shkedy reference does not obviate the deficiencies of the Pitroda and Barlow references with regard to the loan option.

Moreover, the Shkedy reference does not teach a *plurality* of financial transaction *options* as asserted by the Examiner. Instead, the Shkedy reference merely discloses a single pooled purchase order 265. *See* Shkedy, Abstract; Summary.

In view of these deficiencies, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 50.

***Independent Claim 51***

Again, the Applicant respectfully asserts that the cited references fail to teach or suggest, alone or in combination, certain features recited by independent claim 51.

For example, as discussed above, the cited references do not disclose "a *plurality of financial transaction options* tailored to the client data, wherein the plurality of financial transaction options comprise a *lease option*." In the Final Office Action, the Examiner relied solely on the Shkedy reference for its alleged teaching of these features. *See* Paper No. 8, p. 3. However, as discussed above, the Examiner did not specifically address the lease option. Moreover, the Applicant asserts that the forward purchase order (FPO) 100 of Shkedy is not an *option*, as suggested by the

Examiner. Also, the forward purchase orders (FPOs) 100 are all aggregated into a single pooled purchase order 265, which subsequently results in a single lowest price for the buyers. *See Shkedy, Abstract; Summary.* Thus, the Shkedy reference does not teach a plurality of options, much less a plurality of financial transaction options tailored to the client data, as recited by independent claim 51.

In view of these deficiencies, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 51.

***Independent Claim 52***

Independent claim 52 recites, *inter alia*, “*a plurality of financial transaction options* tailored to the client data, wherein the plurality of financial transaction options comprise a *loan option*.” As discussed in detail above, the cited references, taken alone or in combination, fail to teach or suggest these claim features. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 52.

***Independent Claim 53***

Similarly, independent claim 53 recites, *inter alia*, “*a plurality of purchasing options* tailored to the client data wherein the plurality of purchasing options comprise a *lease option*.” For the reasons discussed in detail above, the Applicant emphasizes that the cited references fail to teach or suggest, taken alone or in combination, these claim features of independent claim 53. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 53.

***Independent Claim 54***

Turning to independent claim 54, this claim recites “*a plurality of purchasing options* tailored to the client data, wherein the plurality of purchasing options comprise a *loan option*.” Again, for the reasons discussed in detail above, the cited references fail to teach or suggest, alone or in combination, these features of independent claim 54. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 54.

***Independent Claim 55***

For similar reasons as discussed above, the cited references fail to teach or suggest various features recited by independent claim 55. Specifically, the cited references fail to teach or suggest, alone or in combination, the act of “generating a *plurality of transaction options* tailored to the client data, wherein generating a plurality of transaction options comprises providing *lease and loan options* tailored to the client data.” Again, the Examiner previously admitted that the Pitroda and Barlow references lack these claim features. *See* Paper No. 6, p. 5. In addition, the Applicant asserts that the Shkedy reference does not obviate the deficiencies of Pitroda and Barlow. For these reasons, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 55.

***Independent Claim 56***

Turning to the next independent claim, the present independent claim 56 recites “*client trade-in information*” and a “*plurality of purchasing options comprise lease and loan options.*” As discussed above, the Examiner relied on Shkedy for its alleged teach of these features. However, the Shkedy reference teaches only exchange and bartering transactions, rather than any sort of *client trade-in* as recited by claim 56. *See* Shkedy, col. 8, ll. 15-20; col. 27, ll. 8-13. Moreover, the Examiner failed to identify any teaching of *lease and loan options* in the Shkedy reference. Finally, the Shkedy reference does not teach a *plurality of purchasing options*, as suggested by the Examiner. Instead, the Shkedy reference teaches only a single pooled purchase order (PPO) 265 resulting in a single lowest price for the buyer. *See* Shkedy, Abstract; Summary. In view of these deficiencies, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 56.

***Independent Claim 57***

The Applicant also believes that independent claim 57 is patentable over the cited references, which fail to teach or suggest a “*plurality of purchasing options comprise a lease option*” as recited by claim 57. In the Office Action, the Examiner relied solely on the Shkedy reference for its alleged teaching of these features. *See*

Paper No. 8, p. 3. However, as discussed in detail above, the Shkedy reference does not teach a plurality of purchasing options, much less a *lease option* as recited by claim 57. Instead, the Shkedy reference teaches only a single pooled purchase order (PPO) 265, which results in a single lowest price of goods for the buyers. *See* Shkedy, Abstract; Summary. In view of these deficiencies, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 57.

***Independent Claim 58***

Turning to independent claim 58, this claim recites “*a plurality of purchasing options* tailored to the client data, wherein the plurality of purchasing options comprise a *loan option*.” Again, for the reasons discussed in detail above, the cited references fail to teach or suggest, alone or in combination, these features of independent claim 58. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 58.

***Independent Claim 59***

The cited references, taken alone or in combination, also lack certain features recited by independent claim 59. Specifically, the cited references fail to teach or suggest, alone or in combination, the acts of “receiving *client trade-in information* at the financial module” and “generating a *plurality of transaction options* tailored to the client data,” as recited by claim 59. In the Office Action, the Examiner relied solely on Shkedy for its alleged teaching of these features. *See* Paper No. 8, p. 3. However, as discussed in detail above, the Shkedy reference is absolutely devoid of these claim features. For example, instead of the claimed client trade-in information, the Shkedy reference discloses a contract involving an exchange of goods or a bartering transaction. *See* Shkedy, col. 8, ll. 15-20; col. 27, ll. 8-13. Moreover, the forward purchase orders (FPOs) 100 of Shkedy are not options, much less transaction options, as suggested by the Examiner. In fact, all of these forward purchase orders 100 are aggregated into a single pooled purchase order 265, which subsequently results in a single lowest price for the buyers. *See* Shkedy, Abstract; Summary. In view of these deficiencies, the cited references fail to teach or suggest, taken alone or in

combination, these various features of claim 59. Therefore, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 59.

***Independent Claim 60***

For similar reasons as discussed above, the cited references fail to teach or suggest various features recited by independent claim 60. Specifically, the cited references fail to teach or suggest, alone or in combination, the act of "generating a *plurality of transaction options* tailored to the client data, wherein generating a plurality of transaction options comprises providing *lease and loan options* tailored to the client data." Again, the Examiner previously admitted that the Pitroda and Barlow references lack these claim features. *See* Paper No. 6, p. 5. In addition, the Applicant asserts that the Shkedy reference does not obviate the deficiencies of Pitroda and Barlow. For these reasons, the Applicant respectfully requests that the Examiner withdraw the rejection of independent claim 60.

**Conclusion**

The Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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